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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,907	10/13/2005	Leslie Donald Selsdon	GJ-268J	6962

7590

09/05/2006

Iandiorio & Teska  
260 Bear Hill Road  
Waltham, MA 02154

EXAMINER
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CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/552,907

**Applicant(s)**

SELSDON, LESLIE DONALD

**Examiner**

Ivars C. Cintins

**Art Unit**

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/13/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The term "the foam" (claim 18, line 2) lacks antecedent basis in the claims, and is therefore indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 7, 9, 10 and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Swanson et al. (U.S. Patent No. 5,679,251; hereinafter "Swanson"). The reference discloses a filter comprising powdered activated carbon (see col. 2, line 38), a retainer for the carbon (see col. 1, lines 50-51), and a support member of the type recited (see Figs. 4 and 5; and col. 3, line 56 through col. 4, line 9). Applicant should note that the intended use of a device (i.e. to remove mutagens from engine oil) is not a structural limitation, and hence cannot be relied upon to patentably distinguish apparatus claims. It is well settled that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson.

The reference discloses the claimed invention with the exception of the recited particle size (i.e. 44 micron) for the activated carbon. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ activated carbon particles having the recited size in the filter element of the reference, since this particle size would satisfy the requirement by Swanson that the activated carbon powder have a "flour-like consistency" (see col. 2, line 39).

Claims 5, 6, 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson in view of Applicant's admitted prior art. Swanson discloses the claimed invention with the exception of the recited retainer material. Applicant has admitted that oil filtration materials of the type recited are known in the art (see page 10, lines 8-19 of the specification). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the admittedly known filtration material for the retainer material (i.e. paper) of Swanson, since this admittedly known filtration material is capable of retaining activated carbon particles and filtering engine oil in substantially the same manner as the paper of the reference filter, to produce substantially the same results.

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Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson in view of Semar (U.S. Patent No. 5,589,059). Swanson discloses the claimed invention with the exception of the recited non-return valve. Semar discloses incorporating a non-return (i.e. check) valve in an engine oil filtration system, in order to prevent backflow out of the oil filter (see col. 3, lines 65-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Swanson with the check valve disclosed by Semar, in order to obtain the advantages disclosed by this secondary reference (i.e. prevention of backflow) for the system of the primary reference.


Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson in view of Brownawell et al. (U.S. Patent No. 5,069,799; hereinafter "Brownawell"). Swanson discloses the claimed invention with the exception of the recited threaded outlet. Brownawell discloses an oil filter having a threaded outlet; and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the oil filter of Swanson with the housing having a threaded out disclosed by Brownawell, in order to facilitate connection of this oil filter to the oil circuit of this primary reference system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is 571-272-1155. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Duane Smith, can be reached at 571-272-1166.

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The centralized facsimile number for the USPTO is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Ivars C. Cintins**  
**Primary Examiner**  
**Art Unit 1724**

I. Cintins  
August 31, 2006